



04-19-06

PATENT *[Signature]*

Attorney's Docket No. 047307/258663

**In The United States Patent And Trademark Office**

Appl. No.: 09/497,383 Confirmation No.: 7431  
Applicant(s): David L. Bahr, et al.  
Filed: February 3, 2000  
Art Unit: 2143  
Examiner: George C. Neurauter  
Title: SYSTEM AND METHOD FOR SCANNING A DOCUMENT IN  
CLIENT/SERVER ENVIRONMENT

Docket No.: 047307/258663  
Customer No.: 00826

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Alexandria, VA 22313-1450

**APPEAL BRIEF TRANSMITTAL  
(PATENT APPLICATION – 37 C.F.R. § 41.37)**

- 1. Transmitted herewith is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on January 4, 2006.
- 2. ☐ Applicant claims small entity status.
- 3. Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief is:  
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Respectfully submitted,

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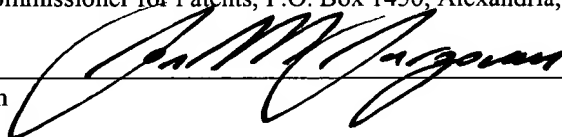
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In re: David L. Bahr, et al.  
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Filing Date: February 3, 2000  
Page 2

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**APPEAL BRIEF UNDER 37 CFR § 41.37**

This Appeal Brief is filed pursuant to the "Notice of Appeal to the Board of Patent Appeals and Interferences" filed January 4, 2006.

1. ***Real Party in Interest.***

The real parties in interest in this appeal are InterTech Information Management, Inc., a Georgia corporation and the assignee of the above-referenced patent application, and its parent ChartOne, Inc., a Delaware corporation, which acquired all interest in InterTech Information Management, Inc.

2. ***Related Appeals and Interferences.***

There are no related appeals and/or interferences involving this application or its subject matter.

3. ***Status of Claims.***

Claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62 and 64-75 were rejected under 35 U.S.C. 102 as being anticipated by a "Quillix Data Sheet", asserted by the Examiner to be admitted prior art. Applicant appeals this rejection.

Claims 2, 23 and 63 were rejected under 35 U.S.C. 103(a) as being obvious in view of the "Quillix Data Sheet." Applicant appeals this rejection. 04/20/2006 BABRAHA1 00000018 160605 09497383

Claims 17, 28, 34, 54, 76 have been canceled. 01 FC:1402 500.00 DA

4. ***Status of Amendments.***

No amendments have been filed subsequent to the final rejection dated November 17, 2005.

5. ***Summary of Claimed Subject Matter.***

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.

Independent Claim 1 is directed to a method (FIG. 4) comprising the step of a) generating a display (FIG. 3) based on a hypertext mark-up language (HTML) document (33)(FIG. 2) stored in a client device (10) using a web browser of a user interface (32) of the client device (10). The display includes a document display portion (38), an index field portion (39), and a control portion (34) all visibly defined in the display in separate portions thereof by the HTML document. The document display portion includes a display of document data (40) received from a scanner (11) coupled to the client device (10), the scanner (11) generating the document data (40) by scanning a document in print form, the document data representing the scanned document. The index field portion permits index data (41) to be input by a user with an input device (15, 16) of the client device into the user interface in association with the document data. The control portion includes at least one control element (50) operable by the user with the input device for generating a start scan signal to initiate scanning of the document with the scanner FIG. 5A; Steps S5) to generate the document data and for generating a send data signal to transmit the document data with the index data displayed by the web browser from the client device to the server over a network using a destination address for the server specified in an address field of the web browser (FIG.3; FIG. 5C, Step S21).

Independent Claim 9 is directed to a method (FIG. 4) comprising the step of: a) generating at a client device (10) a start scan signal (FIG. 5A, Step S5) using a control element (FIG. 3; 50) defined by a hypertext mark-up language (HTML) document stored in the client device and displayed by a web browser of a user interface (32) of the client device in response to a user's operation of an input device of the client device. The method also comprises the steps of b) at the client device, converting the start scan signal into a form compatible with a scanner (p. 9, ll. 22-26); c) at the client device, transmitting the converted start scan signal from the client

device to the scanner (p.9, ll. 20-35); d) receiving the converted start scan signal at the scanner (p. 9, l. 35 – p. 10, l. 1); and e) scanning a document with the scanner to generate document data, in response to the converted start scan signal received in said step (d).

Independent Claim 27 is directed to a method comprising the steps of: a) generating a start scan signal (FIG. 5A; Step S5) using a control element (50) defined by a hypertext mark-up language (HTML) document (35) stored in the client device (10) and displayed by a web browser of a user interface (32) of a client device, the control element operated by a user with an input device (15,16) of the client device. The method also comprises the steps of b) at the client device (10), converting the start scan signal into a form compatible with the scanner (p.9, ll. 26-27); c) transmitting the converted start scan signal from the client device to a scanner (p.9, ll. 32-35; FIG. 5A, Step S6); d) receiving the converted start scan signal at the scanner (FIG. 5A, Step S7); and e) scanning a document in print form with the scanner to generate document data, in response to the converted start scan signal received in said step (d) (FIG. 5A, Step S8). The method further comprises the steps of f) transmitting the document data from the scanner to the client device (FIG. 5B, Step S9); g) receiving the document data at the client device (FIG. 5B, Step S10); h) at the client device, converting the document data into a form that can be displayed by the web browser of the client device (p. 10, ll. 1-5); and i) generating a display including the scanned document in the HTML document displayed within the web browser of the user interface of the client device, based on the document data converted in said step (h) (FIG. 5B, Step S16). Furthermore, the method comprises the steps of j) inputting predetermined index data into a field defined separately from a document display portion for the document data in the HTML document displayed by the web browser of the user interface of the client device, the index data associated with the document data displayed by the web browser (FIG. 5C, Step S19); k) generating a send data signal using a control element defined in the HTML document displayed by the web browser of the user interface of the client device (FIG. 5C, Step S21); l) transmitting the document data and index data from the client device to the server over an internetwork in response to the send data signal generated in said step (k) using a destination address of the server specified in an address field of the web browser (FIG. 5C, Step S22); m) receiving the document data and index data at the server via the internetwork (FIG. 5C, Step S23); and n) storing the document data received in step (m) in association with the index data in

a database of a data storage unit separate from the server (FIG. 5C, Step S24).

Independent Claim 41 is directed to a system (FIGS. 1-3) comprising a client device (10), scanner (11), and server (28, 29). The client device includes a processor (12); a memory (13) coupled to the processor; an input device (15, 16) coupled to the processor; and a display unit (17) coupled to the processor. The scanner and server are coupled to the processor. The processor operates under a predetermined control program (31) stored in the memory to generate a display (33) on the display unit based on a hypertext mark-up language (HTML) document (35) stored in the memory. The display generated by the HTML document includes a document display portion (38), an index field portion (39), and a control portion (34) separately defined in the display. The document display portion displays document data (40) received from the scanner. The document data is generated by scanning the document with the scanner. The index field portion permits index data (41) to be input by a user via the input device (15,16) for association with the document data. The control portion includes at least one control element (50) operable by the user with the input device for use in generating at least a start scan signal to initiate scanning of the document with the scanner and for use in generating a send data signal with the input device to transmit the document data with the index data to the server over a network (3) using a destination address from an address field (FIG. 3) of the display of the client device.

Independent Claim 50 is directed to a system (FIGS. 1-3) comprising a client device (10), a scanner (11), a server (28, 29), and a database storage unit (30). The scanner is coupled to the client device, the server is coupled to the client device via the network, and the database storage unit is coupled to the server. The client device receives document data (40) generated by the scanner by scanning a document. The client device has a user interface (32) capable of generating a display (33) by execution of an hypertext mark-up language (HTML) document (35) stored by the client device. The display includes a document display portion (38), an index field portion (39), and a control portion (34) separately defined in the display. The document display portion displays document data (40) received from the scanner. The document data is generated by scanning the document in print form with the scanner. The document data represents the scanned document. The index field portion (39) permits index data (41) to be input by a user via an input device of the client device for association with the document data.

The control portion includes at least one control element (50) operated by the user with the input device (15, 16) for use in generating at least a start scan signal with the input device to initiate scanning of the document with the scanner and for use in generating a send data signal with the input device to transmit the document data with the index data to the server over the network using a destination address from an address field (p. 13, ll. 1-5) of the display. The server stores the document data and index data in the database storage unit (p. 12, ll. 33-35).

Independent Claim 55 is directed to a system comprising: a plurality of subsystems (1, 2), at least one server (28, 29), and a database storage unit (30). The plurality of subsystems is coupled to the network (3). The subsystems have respective client devices (15,16) capable of displaying document data (40) included within respective hypertext mark-up language (HTML) documents (35) displayed on corresponding web browsers (32) thereof. At least one of the subsystems (1, 2) includes a scanner (11, 21) coupled to a respective client device (10, 20). The scanner (11, 21) generates the document data (40) by scanning a document in print form based on a first command from a user entered into the web browser of the client device coupled to the scanner (p.9, ll. 19-20). The client device receives the document data from the scanner (p.10, ll. 1-3) and generates a display of the document data in the web browser thereof (p. 10, ll. 14-18). The client device transmits the document data based on a second command from the user entered into the web browser of the client device (p. 10, ll. 18-21). The server is coupled to the network (3), and receives the document data from the client device over the network using a destination address specified in an address field of the web browser of the client device (p. 12, ll. 27-29). The system further comprises a database storage unit coupled to the server (FIG. 1, 2), the database storage unit separate from the server, the database storage unit storing the document data so that the subsystems can access the document data (p. 12, ll. 33-35).

Independent Claim 57 is directed to a method comprising the steps of: a) generating a display (33) including a display portion (38) with a view of a scanned document within a browser (32) of a client device (10) based on document data (40) derived from a scan of a document in print form (FIG. 5B, Step S16). The method also comprises b) inputting predetermined index data (41) into at least one field of an index field portion (39) of the display within the browser of the client device (FIG. 5C, Step S19). The index field portion is defined in the display within the browser separately from the display portion (FIGS. 2, 3). The method

further comprises c) generating a send data signal from within the browser of the client device using a control element of a control portion defined separately from the index field portion and the display portion in the display within the browser (FIG. 5C, Step S21; FIG. 3, p. 10, ll. 18-21). In addition, the method comprises d) transmitting the document data and index data from the client device to the server over an internetwork with the control element of the control portion using a destination address of a server identified in an address field (FIG. 5C, Step S22; FIG. 3, p. 13, ll. 1-5) of the browser in response to the send data signal generated in said step (c). Furthermore, the method comprises the steps of: e) receiving the document data and index data at the server (FIG. 5C, Step S23); and f) storing the document data in association with the index data received from the server in a database of a data storage unit separate from the server (FIG. 5C, Step S24).

**6. *Grounds of Rejection to be Reviewed on Appeal.***

A concise statement of each ground of rejection presented for review:

I. Whether Claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62, and 64-75 are patentable under 35 U.S.C. 102 (section not specified) over "Quillix Data Sheet" alleged to be admitted prior art;

II. Whether Claims 2, 23, and 63 are Nonobvious under 35 U.S.C. 103(a) over the "Quillix Data Sheet" alleged to be admitted prior art

**7. *Argument.***

**I. Claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62, and 64-75 are patentable over "Quillix Data Sheet" alleged to be admitted prior art**

**A. Insufficient Reasons Stated for Rejection**

In the final Office action, Claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62, and 64-75 were rejected under 35 U.S.C. 102 based on the Quillix data sheet. The Quillix data sheet has a print date of March 28, 2000, thus after the priority date of the subject application of February 3, 2000. The Office action also mentions a press release regarding the Quillix software product dated January 18, 2000. The Examiner alleges applicant's statements made with regard to the January 18, 2000 press release establish the Quillix data sheet as prior art to the subsection application, even though it was printed after the priority date of the subject application.



Applicant cannot determine from the record what the Examiner is relying upon as prior art, and how it relates to a particular section of 35 U.S.C. 102. 35 U.S.C. 132 and procedural due process under the 5<sup>th</sup> Amendment to the U.S. Constitution require that the Examiner notify the Applicant of the grounds for rejection. *In re Foster*, 52 C.C.P.A. 1808, 343 F.2d 980, 999 (C.C.P.A. 1965)(a rejection so vaguely stated may well amount to a denial of the procedural safeguards provided in 35 U.S.C. 132); *Chester v. Miller*, 906 F.2d 1574 (Fed. Cir. 1990)(Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection)(citing *In re Wilke*, 50 C.C.P.A. 964, 314 F.2d 558, 562, 136 USPQ 435, 439 (1963)(the Examiner should state the rejection so that there is no ambiguity in the grounds therefor); *In re Hughes*, 52 CCPA 1355, 345 F.2d 184, 185, 145 USPQ 467, 468 (1965))(procedural due process and 35 U.S.C. 132 require that whenever a rejection is made, the Commissioner 'shall notify the applicant thereof, stating the reasons for such rejection). Accordingly, reversal of the rejection of Claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62, and 64-75 is requested for this reason.

#### **B. Quillix Data Sheet is Not Admitted Prior Art**

The primary reference relied upon to reject the Claims is a Quillix data sheet bearing a print date of March 28, 2000, which is necessarily the earliest possible date on which the Quillix Data Sheet could have been published. The Office Action mentions a press release "Prevalent Software Inc. Introduces Quillix" dated January 18, 2000, [www.prevasoft.com/press011880.shtml](http://www.prevasoft.com/press011880.shtml) indicating that "Quillix" was "introduced" on January 18, 2000.

The statement allegedly admitting that the Quillix data sheet is prior art appears at pages 60-61 of Applicant's amendment filed May 7, 2004, which is set forth as follows:

Thus, according to Prevalent Software, Inc., "Quillix is the first true enterprise, distributed capture system built for the Internet." Further, IDT's President characterizes the Quillix solution as "a revolutionary document and data capture product for the eCommerce industry." This is further evidence of the long-felt need in the art for the claimed invention – to be the "first true

enterprise, distributed capture system built for the Internet,” and “revolutionary,” there must have been a long-felt need for the claimed invention (not to mention attempts by others that had failed to attain the claimed invention). Because Quillix appears to contain similar or the same functionality as the claimed invention, it is submitted that there was a long-felt need in the art for the claimed invention that was not satisfied until the claimed invention was made. [Emphasis added]

Contrary to the Examiner's assertion, this statement does not admit that the Quillix data sheet is "prior art." The point made in this statement is merely that Prevalent Software, Inc's President considered his company's product “revolutionary” and the “first true enterprise, distributed capture system built for the Internet.” To the contrary, Applicant's inventors were the first to invent the claimed subject matter. However, that another company regarded its product as new at a point in time near the filing date of the claimed invention tends to show that the claimed invention was new to the extent the two have the same or similar functionality. The Examiner has failed to consider that the claimed invention was invented before the Quillix data sheet so that it is not prior art to the subject application, and this conclusion is in no way inconsistent with Applicant's statement above.

Also, the statement indicates that the long-felt need for the invention was not satisfied until the claimed invention, not the Quillix product, was made. Logically, this statement could only properly be interpreted to mean that the claimed invention is patentable over the Quillix data sheet (Exhibit 21 - Amendment filed May 7, 2004). The Examiner's conclusion that the above statement was tantamount to an admission of prior art is directly contradictory to what is stated.

Moreover, use of the phrase “appears to contain similar or the same functionality” allows that the Quillix software may not be the same as the claimed invention, but only similar, given the documents of record (e.g., Exhibit 21, Amendment filed May 7, 2004) do not disclose the claimed invention. Furthermore, the statement may apply to some claims and not others, or only to aspects of some of the claims. The Examiner has failed to consider these possibilities, which are in fact the case.

Subsequent to the May 7, 2004 Response, in Applicant's Amendment filed February 14, 2005, numerous Claims were amended. For example, Claim 1 was amended to state "a document display portion, an index field portion, and control portion all visibly defined in the display in separate portions thereof by the HTML document"; and Claims 41, 50 were amended to state "the display generated by the HTML document including a document display portion, an index field portion, and a control portion separately defined in the display." For reasons of record which will be specifically addressed in a subsequent section, these amendments render the Claims patentable over the Quillix Data Sheet.

Furthermore, the Quillix data sheet is itself the best source to determine what it states. It is improper to interpret Applicant's statement in a manner contrary to the content of the documents relied upon by the Examiner. To interpret Applicant's statement as an admission that the document is prior art in the presence of a print date of March 28, 2000 and the statement that the "Information in this document is subject to change without notice..." making it uncertain what it disclosed at any given time prior to its print date, would be contrary to what the document itself states. Applicant requests reversal of the rejection and remand with instructions to the Examiner to issue a Notice of Allowance for all pending claims.

In an attempt to support its position, the Office action cites *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 U.S.P.Q.2d 1331, 1337 (Fed. Cir. 2003). This case found that even though an applicant had labeled certain patents as "prior art" in an information disclosure statement (IDS), that nonetheless, this identification was held not to be an admission of prior art against the applicant. In this case there has been no labeling of the Quillix data sheet, press release or software product as "prior art." In *Riverwood* the Federal Circuit distinguished an earlier decision, *In re Nomiya*, 509 F.2d 566, 571 n. 5, 184 U.S.P.Q. 607, 611 n. 5 (CCPA 1975) on the basis that labeling another's work as prior art constituted an admission. In *Nomiya*, the applicants labeled certain Figures as prior art and described them as such in the specification. In the present case, Applicant has never stated that the Quillix Data Sheet, press release, or software product is "prior art" so *Nomiya* is not applicable to the present facts. In *Riverwood*, the Federal Circuit also cited *In re Fout*, 675 F.2d 297, 300, 213 U.S.P.Q. 532, 535 (CCPA 1982) for the

proposition that applicant's admission of actual knowledge of the prior invention of another, which was described in the preamble of a Jepson claim, was held to constitute an admission that the described invention was prior art to the applicant. Applicant has not taken any action implicitly admitting the Quillix data sheet, press release, or software product as prior art, for example, by its inclusion in the preamble of a Jepson claim. Therefore, *Fout* is distinguishable from this case in which applicant has not engaged in any conduct that could be taken as an admission of prior art. As to *In re Hellsund*, 59 C.C.P.A. 1382, 474 F.2d 1307, 1310-11, 177 U.S.P.Q. 170 (C.C.P.A. 1973), the applicant admitted prior invention by another both on the record and in interviews with the Examiner. The present case involves no admission of prior invention by another. Regarding *In re Garfinkel*, 437 F.2d 1000, 168 U.S.P.Q. 659 (C.C.P.A. 1971), the examiner in that case took the position that a published article was prior art based on an earlier paper in which a footnote in the article indicated it was based on the earlier paper, that the applicant allegedly treated the article as prior art by filing a 131 affidavit, statements by applicant's counsel that author of paper and article was first in field and that the invention in question was an improvement on the process, and that applicant and others heard the presentation of the paper and returned to the US afterward. In a footnote *Garfinkel* notes that the applicant's admission that the paper was prior art made it unnecessary to determine whether it was prior art under 35 U.S.C. 102(a), (f) or (g). *Garfinkel* must be reconsidered in light of *Credle v. Bond*, 25 F.3d 1566, 30 U.S.P.Q.2d 1911 (Fed. Cir. 1994) which holds "[T]he mere filing of [a §1.131] affidavit or declaration [seeking to show that an invention date before a reference relied upon by the PTO to reject a claimed invention] does not constitute an admission that the reference sought to be antedated renders the invention in question unpatentable." In addition, as previously noted, the Federal Circuit case of *Chester v. Miller* interprets procedural due process and 35 U.S.C. 132 to require the Examiner to state the reasons for a rejection, so the *Garfinkel*'s assertion that it was unnecessary to determine which section of 102(a), (f), or (g) applies appears not to be current law. In the present case, there has been no statement in the record attributable to Applicant that admits that another was first to invent or that the claimed invention is an improvement over the work of another. Therefore, *Garfinkel* does not apply to the present application. *In re Blout*, 333 F.2d 928, 142 U.S.P.Q. 173 (C.C.P.A. 1964) involved a concession by an applicant that if a patent is available as a reference, then this patent would bar

the claims at issue, unless applicant's Rule 131 affidavits were found sufficient to remove the patent. In fact, the Rule 131 affidavits contained admissions that the patent in question was prior art. Applicant in the present case has made no such concession or admission in its Rule 131 declaration or otherwise. Finally, the Examiner relies upon *In re Lopresti*, 333 F.2d 932, 142 U.S.P.Q. 177 (C.C.P.A. 1964) in which the applicants stated that their invention was an improvement upon another's invention but filed Rule 131 affidavits antedating the other's invention. The applicant's statement in its application was inconsistent with the filed Rule 131 affidavits, so the C.C.P.A. disregarded the affidavits. In the present case, there is no such inconsistency. Applicant's statements that the Quillix data sheet is not prior art are entirely consistent with the statement that "Quillix appears to contain similar or the same functionality as the claimed invention." Applicant simply invented the claimed subject matter before the Quillix data sheet, press release or software product was "introduced."

The BPAI has noted in several cases that when, as here, there is no admission of prior art, the Examiner's rejection must fail. In *Ex Parte Paul G. Carey*, 2002 WL 1821721 (Bd.Pat.App. & Interf.), the applicant stated in its specification that both silversilicone paste and a hardening agent were known in the prior art and commercially available, but not the mixture of the two. There was thus no admission in the appellant's specification that the mixture of the two was known in the art. The B.P.A.I. held the absence of any admission to be the fatal flaw in the Examiner's rejection. In *Ex Parte Nobuyoshi Nishikawa*, 2000 WL 33534682 (Bd.Pat.App. & Interf.), the appellant in that case stated in its specification that certain adhesives recited in the claims were disclosed in three US patents, and the Examiner combined this with other prior art disclosures. The B.P.A.I. held that "[t]he examiner has provided no realistic rationale why one of ordinary skill in this art would have found in this obviously diverse collection of prior art disclosures and "prior art admissions," which do not even set forth a bare outline of a three step adhering method, any objective teaching suggestion or motivation leading to the claimed invention as a whole, including each and every limitation of the claims." *Id. at 2*. *Ex Parte Zager et al.*, 2001 WL 1176477 (Bd.Pat.Interf. & Interf.) involved a computer system placing an address tag array inside a microprocessor chip and a data array in memory on a different chip, and accessing those arrays in sequential manner rather than in the conventional simultaneous

manner. The appellants conceded in their brief that there was an inherent relationship between where arrays are disposed and their access timing. The BPAI held this concession was not an admission that the prior art disclosed accessing the arrays in a non-sequential manner contrary to conventional simultaneous access, and thus reversed the rejection. In *Ex Parte Alberto Ciarla*, 2002 WL 1801096 (Bd. Pat.App. & Interf.), the BPAI noted that a statement made in an amendment was not an admission that an element of a claimed invention was prior art. In *Ex Parte Patrizia Milazzo*, 2002 WL 1821709 (Bd.Pat.App. & Interf.), the BPAI held that the appellants had not admitted the problem of unnecessary current consumption of the prior art figure was known. The appellants recognized that the prior art power transistor suffered from current consumption when in an off state. However, the appellants did not state that the current consumption was known to others, and recognition of the problem did not amount to an admission that it was known what the source of the problem was or the circuitry required to correct it. Accordingly, the rejection was reversed by the BPAI. So, too, in the present case should the rejection be reversed.

Many courts have been reluctant to imply an admission of prior art without a clear basis for it. For example, In *International Cellucotton Products Co. v. Sterilek Co., Inc.*, 94 F.2d 10, 37 U.S.P.Q. 6 (2d Cir. 1938), the inventor's limiting of a claim to avoid a reference did not constitute admission that that reference is prior art. In *France Mfg. Co. v. Jefferson Electric Co.*, 106 F.2d 605, 610-11, 43 U.S.P.Q. 53 (6<sup>th</sup> Cir. 1939), the opening statement by plaintiff's counsel to the effect that certain elements if the invention were known in the prior art was not a binding admission that claims not declared on, involving such elements, were invalid. In *Reading & Bates Constr. Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 651, 223 U.S.P.Q. 1168 (Fed.Cir. 1984), the attorney who prosecuted subsequent patent application admitted that brochure advertising process set forth in prior patent issued to same inventive entity was prior art, but this was not equivalent of an admission that the brochure constituted an enabling disclosure of the invention claimed in the subsequent patent. In *Beckson Marine Inc. v. NFM, Inc.*, 292 F.3d 718, 63 U.S.P.Q.2d 1031 (Fed.Cir. 2002), the patentee's previous infringement claim against what it later discovered was prior art did not, without more, constitute admission that patent was invalid as obvious or anticipated by prior art. In *A&E Products Group, L.P. v.*

*Mainetti USA Inc.*, 301 F.Supp.2d 265 (S.D.N.Y. 2004), a patent applicant's submission of third-party affidavit as prior art did not constitute admission that affidavit was prior art for related patent previously obtained by applicant.

Similarly, in the related context of prosecution history estoppel in which the applicant's admissions during prosecution prevent the applicant from later asserting claim scope for subject matter surrendered during prosecution, the Federal Circuit has numerous times held that disavowal of claim scope in the prosecution history must be clear and unmistakable. *Aquatex Industries, Inc. v. Techniche Solutions, Inc.*, 419 F.3d 1374, 1382, 76 U.S.P.Q.2d 1213 (Fed.Cir. 2005)(citing *Pharmacia & Upjohn Co. v. Mylan Pharm., Inc.*, 170 F.3d 1373, 1376-77 (Fed.Cir.1999)). In the present case, the alleged surrender of patent scope, in this case asserted by the Examiner to have been total, is based upon the statement addressing allegations of Prevalent Software, Inc.'s officer that "...Quillix appears to contain similar or the same functionality as the claimed invention." This is far from a "clear and unmistakable" admission of prior art required under Federal Circuit precedent. For instance, the Office action has failed to consider that the Quillix Data Sheet, press release and software product may be evidence of infringement of the claimed invention (see *Beckson Marine Inc. v. NFM, Inc.* decision noted above), or to the extent the subject matter is overlapping, that the Applicant invented the claimed invention first, or that the press release does not enable the artisan to make and use the invention, or that "introduction" may not mean offer of sale or public use, etc. Therefore, the Quillix data sheet, press release and software product are not admitted prior art to the claimed invention. Applicant requests the B.P.A.I. to reverse the rejections of Claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62, and 64-75 under 35 U.S.C. 102 and 103(a) with instructions on remand to the Examiner to issue a Notice of Allowance for these Claims.

### **C. Office Action's Effective Refusal to Consider Evidence of Conception and Reduction to Practice**

The Examiner effectively refused to consider the Declaration of Alexandre Okonechnikov including attached corroborative evidence submitted with Amendment filed July 21, 2005, which establishes conception and actual reduction to practice before the date of the Quillix data sheet,

press release or product. The Examiner stated that the status of the Quillix data sheet as alleged admitted prior art made it unnecessary to further consider evidence of conception and reduction to practice before the print date of the Quillix data sheet. Such refusal was improper. As explained above, Applicant has never admitted that the Quillix data sheet, press release or software product are prior art to the claimed invention. The B.P.A.I. has held that it is procedural error for an Examiner not to consider a Declaration submitted under 37 C.F.R. 1.131. *Ex Parte Elizabeth S. Ward*, 2002 WL 1801234, p. 2 (B.Pat.App. & Interf.). Evidence that supports, rather than negates, patentability must be fairly considered. *Ex Parte Gary B. Larson*, 2002 WL 1821722, p. 2, (Bd.Pat.App. & Interf.). The refusal to consider the Declaration is also contrary to M.P.E.P. §715, and procedural and substantive due process of law under the U.S. Constitution, 5<sup>th</sup> Amendment. Accordingly, reversal of the rejection and remand to the Examiner with instructions to issue a Notice of Allowance for Claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62, and 64-75 under 35 U.S.C. 102 is requested on this ground.

**D. The Claimed Invention Patentably Distinguishes over the Quillix Data Sheet**

**D.1 Rejection of Claims 1, 3-16, 18-22, 24-27, 29-33, 25-53, 55-62, and 64-75 under  
35 U.S.C. 102 based on alleged admitted prior art Quillix Data Sheet**

On page 5 of the Office action dated November 17, 2005, Claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62, and 64-75 were rejected under 35 U.S.C. 102(a) based on the Quillix data sheet. The reasons that the Quillix data sheet is not prior art have been discussed in detail in Section B above, and all of Claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62, and 64-75 are patentable for this reason. Nonetheless, Claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62, and 64-75 are patentably distinguishable over the Quillix data sheet for at least the following reasons.

Anticipation under 35 U.S.C. §102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990). The language of 35 U.S.C. 102 stating "A person shall be entitled to a patent unless..." has been interpreted as putting the burden on the Examiner to establish a *prima facie* case of anticipation. *In re Gene R. Wilder*, 429 F.2d 447, 450 (CCPA 1970). "Only if this burden is met does the burden of coming forward with rebuttal argument or evidence shift to the applicant." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993).



Claim 1 recites “a document display portion, an index field portion, and control portion all visibly defined in the display in separate portions thereof by the HTML document...” Claim 1 further recites “the index field portion permitting index data to be input by a user with an input device of the client device into the user interface in association with the document data.” The Quillix data sheet does not indicate that the same display includes a document display portion, index field portion, and a control portion on one display. Contrary to the Office action’s assertions, no index field portion is shown together with a document display portion and a control portion in the Quillix data sheet, and thus at least this feature of the claimed invention is missing from the Quillix data sheet. The ‘batch name’ in the Quillix data sheet appears only to be the name given to a local file for temporarily storing scanned documents on the client side. Thus, ‘batch name’ as used in the Quillix data sheet is not index data input by the user which is “a document name or identification number, an index path indicating a subdirectory in which the scanned document is to be stored at the server 28 upon uploading the scanned document, or text explaining the nature of the scanned document or matter or transaction to which the document relates.” Specification, p. 12, l. 20-24. Although the Quillix data sheet indicates that indexing can be performed before or after a batch is released and processed by the Quillix Web Server, the top of the web browser indicates that the “INDEX” tool must be accessed through a different display screen than the “SCAN” display shown. In the claimed invention, by including that which a coder needs to scan, index and upload a document in separate portions of a single display, rather than scattered among multiple screens, time is saved in the coding process, which leads to faster throughput and higher compensation for coders paid to code by the document, and the claimed invention permits healthcare providers to reduce backlogs of medical documents to be coded significantly more quickly than otherwise. None of the Quillix data sheet, press release or software product discloses these features of the claimed invention. Thus, claim 1 is patentable for this reason.

Claims 3-8 depend from Claim 1 and include all of the limitations of that Claim plus additional limitations that are not disclosed in the prior art. For example, Claim 7 recites “wherein the control element can be activated by the user with the input device to scale the document data for display in the document display portion to the same scale as the scanned document.” This

feature is not disclosed in the Quillix data sheet which has no feature capable of scaling the display in the document display portion to the same scale as the scanned document. Specifically, the "FitHeight" and "FitWidth" features fail to accomplish this function. Accordingly, Claim 7 is patentable for this reason.

Claims 9-18 are patentable because the Quillix data sheet is not prior art to the subject application. In addition, Claim 16 recites "wherein the adjusting of said step (j) includes generating the display of the scanned document on the user interface of the client device with the same scale as the scanned document." The "FitHeight" and "FitWidth" features fail to accomplish this function. Accordingly, Claim 16 is patentable for this reason.

Claim 18 recites the step of "k) generating a multiscan mode signal via a user's operation of a control element defined within the web browser at the user interface of the client device, said steps (e)-(g) repeatedly performed to generate document data for a plurality of documents, based on the multimode scan signal." There is no indication in the Quillix data sheet that its system performs any such step. Accordingly, Claim 18 is patentable.

Claim 19 recites "l) generating a selection signal via a user's operation of a control element defined within the web browser of the client device indicating at least one of the first, last, next and previous scanned documents for display" and "m) displaying the document data for one of the scanned documents within the web browser of the client device, based on the selection signal generated in said step (l)." There is no indication in the Quillix data sheet that it performs any such function.

Claim 20 recites a step "k) user inputting predetermined index data into an index field defined by the HTML document separately from a document display portion in which the document data from the scanner is displayed by the web browser of the user interface of the client device." The Quillix data sheet does not disclose inputting data into a display that has a document display portion, an index field portion and a control portion all in one display. Accordingly, Claim 20 patentably distinguishes over the prior art for this reason. In addition, Claim 20 recites "l) generating a send data signal using the control element operated by a user with the input device and defined by the HTML document displayed by the web browser of the user interface of the client device" and "m) transmitting the document data and index data from the client device to the server over an internetwork in response to the send data signal generated

in said step (l).” The system described in the Quillix data sheet is incapable of performing these steps from the same display that shows the document display portion, index field portion and control portion defined together on a single display. Accordingly Claim 20 is patentable for at least these reasons.

Claim 21 recites “wherein the index data includes predetermined identification data to identify the document.” The ‘batch name’ in the Quillix data sheet only identifies a batch stored in a temporary local file, not any particular document. Thus, Claim 21 is patentable for this reason.

Claim 22 recites “wherein the document data and the index data are transmitted between the server and client device in hypertext transfer protocol (HTTP).” There is no indication in the Quillix data sheet that it transmits document data and index data between the server and client device in HTTP. Thus, Claim 22 is patentable for this reason.

Claim 23 recites “wherein the start scan signal and the send data signal are input by the user with the input device via a common control element displayed within the web browser of the user interface that toggles between a first scan mode for the performance of said step (a) and a second send mode for the performance of said step (m).” The Quillix data sheet discloses no such feature.

Claim 24 recites that “the send data signal is input by a user with the input device via a second control element displayed within the web browser of the user interface in the performance of said step (m).” In the Quillix data sheet there is no control element capable of generating a send data signal along with another control element capable of starting scan of a document. Therefore, Claim 24 is patentable over the prior art of record.

Claim 26 recites a step of “f) transmitting the document data from the scanner to a server.” This step is not disclosed the Quillix data sheet which discloses no scanner capable of transmitting document data to a server.

Claim 27 recites a step of “j) inputting predetermined index data into a field defined separately from a document display portion for the document data in the HTML document displayed by the web browser of the user interface of the client device, the index data associated with the document data displayed by the web browser” and “k) generating a send data signal using a control element defined in the HTML document displayed by the web browser of the user interface of the

client device.” The Quillix data sheet discloses no such method steps in which index data is input into a field separate from the document display portion in an HTML document, and a “send data signal” is generated using a control element defined in the same HTML document. This feature enables a coder to work much more quickly than is possible switching between multiple screens. Accordingly, Claim 27 is patentable over the prior art of record for at least this reason.

Claims 29-33 and 35-40 depend, directly or indirectly, from Claim 27 and include all of the limitations of that Claim plus additional limitations that are not disclosed in the Quillix data sheet. For example, Claim 33 recites “wherein the adjusting of said step (o) includes generating the display of the scanned document on the user interface of the client device with the same scale as the scanned document.” There is no corresponding feature disclosed in the Quillix data sheet which is incapable of generating the scanned document on the display with the same scale as the actual scanned document. Accordingly, Claim 33 is patentable over the prior art of record for this reason.

Claim 37 recites “wherein the index data includes predetermined identification data to identify the document.” The ‘batch name’ in the Quillix data sheet only identifies a batch stored in a temporary local file, not any particular document. Thus, Claim 37 is patentable for this reason.

Claim 38 recites “wherein the document data and the index data are transmitted in said step (l) between the server and client device in hypertext transfer protocol (HTTP) format.” There is no indication in the Quillix data sheet that it transmits document data and index data between the server and client device in HTTP. Thus, Claim 38 is patentable for this reason.

Claim 39 recites “wherein the start scan signal and the send data signal are input by the user with the input device via a common control element defined within the web browser of the user interface that toggles between a first scan mode for the performance of said step (a) and a second send mode for the performance of step (l).” The Quillix data sheet discloses no such feature, which makes it possible for a coder to code documents without having to switch between screens to scan and send document data to a server, saving the coder significant time in the coding process.

Claim 40 recites “wherein the start scan signal is input by the user with the input device via a first control element defined within the web browser of the user interface for a first scan mode in the performance of said step (a), and the send data signal is input by the user with the

input device via a second control element defined within the web browser of the user interface in the performance of said step (1).” In the Quillix data sheet there is no control element capable of generating a send data signal along with another control element capable of starting scan of a document. Therefore, Claim 40 is patentable over the prior art of record.

Claim 41 recites a system comprising a “the processor operating under a predetermined control program stored in the memory to generate a display on the display unit based on a hypertext mark-up language (HTML) document stored in the memory, the display generated by the HTML document including a document display portion, an index field portion, and a control portion separately defined in the display, the document display portion displaying document data received from a scanner, the document data generated by scanning the document with the scanner, the index field portion permitting index data to be input by a user via the input device for association with the document data, and the control portion including at least one control element operable by the user with the input device for use in generating at least a start scan signal to initiate scanning of the document with the scanner and for use in generating a send data signal with the input device to transmit the document data with the index data to the server over a network using a destination address from an address field of the display of the client device.” The Quillix data sheet discloses no single display with a document display portion for displaying a scanned document, and index field portion for indexing the document, and a control portion both for controlling a scanner and uploading scanned document data and index data over a network to a server for storage. At least the “index field portion” is missing from the display, and ‘batch name’ as used in the Quillix data sheet is not index data as defined in the subject application which includes “a document name or identification number, an index path indicating a subdirectory in which the scanned document is to be stored at the server 28 upon uploading the scanned document, or text explaining the nature of the scanned document or matter or transaction to which the document relates.” Specification, p. 12, l. 20-24. Although the Quillix data sheet indicates that indexing can be performed before or after a batch is released and processed by the Quillix Web Server, the top of the web browser indicates that the “INDEX” tool must be accessed through a different display screen than the “SCAN” display shown. In the claimed invention, by including that which a coder needs to scan, index and upload a document in separate portions of a single display, rather than scattered among multiple screens, time is saved in the coding process, which leads to faster throughput

and higher compensation for coders paid to code by the document, and the claimed invention permits healthcare providers to reduce backlogs of medical documents to be coded significantly more quickly than otherwise. None of the Quillix data sheet, press release or software product discloses these features of the claimed invention. Thus, claim 41 is patentable for this reason.

Claims 42-49 depend directly from Claim 41 and include all of the limitations of that Claim. Claim 42 recites "wherein the control element alternates between generating the start scan signal and the send data signal between successive activations of the control element by the user with the input device." The Quillix data sheet fails to disclose any such feature, which makes it possible for a coder to use the control element to alternately scan and transmit documents for storage, saving a coder significant time in the coding process. In addition, Claim 47 recites "wherein the control element can be operated by the user with the input device to scale the document data for display in the document display portion to the same scale as the scanned document." No such feature is disclosed in the Quillix data sheet. Claim 48 recites "wherein the control element can be operated by the user with the input device to select document data from among a plurality of scanned documents for display on the document display portion of the display." This feature too is not disclosed in the Quillix data sheet. Claim 49 recites "a database storage unit coupled to the server, the database storage unit being separate from the server, for storing the index data in association with the document data from the processor." The Quillix data sheet is entirely silent regarding a database storage unit.

Claim 50 recites a system with a client device that generates a "display including a document display portion, an index field portion, and a control portion separately defined in the display, the document display portion displaying document data received from the scanner, the document data generated by scanning the document in print form with the scanner, the document data representing the scanned document, the index field portion permitting index data to be input by a user via an input device of the client device for association with the document data, and the control portion including at least one control element operated by the user with the input device for use in generating at least a start scan signal with the input device to initiate scanning of the document with the scanner and for use in generating a send data signal with the input device to transmit the document data with the index data to the server over the network using a destination address from an address field of the display, the server storing the document data and index data in the database storage unit." The Quillix data sheet discloses no such system. At least the "index field portion" is missing from the

display. 'Batch name' as used in the Quillix data sheet is not index data as defined in the subject application which includes "a document name or identification number, an index path indicating a subdirectory in which the scanned document is to be stored at the server 28 upon uploading the scanned document, or text explaining the nature of the scanned document or matter or transaction to which the document relates." Specification, p. 12, l. 20-24. The 'batch name' is none of these, but is merely the name of a temporary file used to locally store scanned documents.

Claims 51-53 depend from Claim 50 and include all limitations of that Claim. Accordingly, Claims 51-53 are patentable by dependency from Claim 50. In addition, the Quillix data sheet is not prior art so these claims are patentable for this reason as well.

Claims 55 and 56 are patentable because the Quillix data sheet is not prior art to the subject application.

Claim 57 recites "b) inputting predetermined index data into at least one field of an index field portion of the display within the browser of the client device, the index field portion defined in the display within the browser separately from the display portion." The Quillix data sheet fails to disclose any such step. 'Batch name' as used in the Quillix data sheet is not index data as defined in the subject application which includes "a document name or identification number, an index path indicating a subdirectory in which the scanned document is to be stored at the server 28 upon uploading the scanned document, or text explaining the nature of the scanned document or matter or transaction to which the document relates." Specification, p. 12, l. 20-24. The 'batch name' is none of these, but is merely the name of a temporary local file used to store scanned documents. Furthermore, step c) recites "generating a send data signal from within the browser of the client device using a control element of a control portion defined separately from the index field portion and the display portion in the display within the browser." The Quillix data sheet discloses no such step made possible using a control element defined separately from the index field portion and the display portion in the display within the browser. Accordingly, Claim 57 is patentable for this additional reason. Furthermore, step d) recites "transmitting the document data and index data from the client device to the server over an internetwork with the control element of the control portion using a destination address of a server identified in an address field of the browser in response to the send data signal generated in said step (c)." The Quillix data sheet discloses no such

step performed in response to a send data signal. In addition, Claim 57 recites “storing the document data in association with the index data received from the server in a database of a data storage unit separate from the server.” This feature is not disclosed in the Quillix data sheet.

Claims 58-59 depend from Claim 57 and include all limitations of that claim plus additional limitations that are not disclosed in the prior art. For example, Claim 59 recites “wherein the send data signal is generated in step (c) by activating a control element defined in the HTML document.” The Quillix data sheet shows no activating of a control element defined in an HTML document to generate a send data signal used to transmit document data and index data to a server. Accordingly, Claims 58-59 are patentable.

Claim 60 recites a step of “b) inputting index data identifying the document data into the index field portion.” Whatever its indexing capability, the system described in the Quillix data sheet is not capable of inputting index data identifying document data into the index field portion of a display that includes a document display portion and a control portion. This feature enables coders to code documents much more quickly than otherwise by avoiding the need to switch between different screens. Therefore, Claim 61 is patentable over the Quillix data sheet.

Claim 61 recites that “the index data input in said step (b) comprises a document name identifying the scanned document.” The ‘batch name’ of the Quillix data sheet is merely a temporary name for a local file used to store a batch of scanned documents, but it does not identify any particular document. Therefore, Claim 61 is patentable over the prior art of record.

Claim 62 recites that “the index data input in said step (b) comprises an identification number identifying the scanned document.” The ‘batch name’ of the Quillix data sheet may identify a batch of scanned documents, but it does not identify any particular document through an identification number. Therefore, Claim 62 is patentable over the prior art of record.

Claim 63 recites “wherein the index data input in said step (b) comprises a file path indicating the subdirectory on the server at which the document data is to be stored.” The ‘batch name’ of the Quillix data sheet is not a file path indicating a subdirectory on the server at which the document data is to be stored. Instead, it is a batch name used locally for a group of scanned documents not specifically identified.” Therefore, Claim 63 is patentable over the prior art of record.

Claim 64 recites “wherein the index data input in said step (b) comprises text explaining



the nature of the scanned document.” The ‘batch name’ of the Quillix data sheet is not text explaining the nature of the scanned document. Accordingly, Claim 64 is patentable over the prior art of record.

Claim 65 recites “wherein the index data input in said step (b) identifies a matter to which the scanned document relates.” The ‘batch name’ of the Quillix data sheet does not identify a matter to which the scanned document relates. Therefore, Claim 65 is patentable over the prior art of record.

Claim 66 recites “wherein the index data input in said step (b) identifies a transaction to which the scanned document relates.” The Quillix data sheet fails to indicate that the ‘batch name’ in any way identifies a transaction to which the scanned document relates. Accordingly, Claim 66 is patentable over the prior art of record.

Claim 68 recites a step of “(b) activating the control element by the user to upload the document data representing the scanned document to a server over a network.” The Quillix data sheet fails to disclose any such step implemented with a control element defined in a display including document display portion, index portion and control portion separately defined in the display. Accordingly, Claim 68 is patentable.

Claim 69 depends from Claim 27 and recites “wherein the index data input in said step (j) identifies the scanned document.” The ‘batch name’ in the Quillix data sheet only identifies a batch stored in a temporary local file, not any particular document. Thus, Claim 69 is patentable for this reason.

Claim 70 recites “wherein the index data input in said step (j) comprises a document name identifying the scanned document.” The ‘batch name’ in the Quillix data sheet only identifies a batch stored in a temporary local file, not any particular document. Thus, Claim 69 is patentable for this reason.

Claim 71 recites that “the index data input in said step (j) comprises an identification number identifying the scanned document.” The ‘batch name’ of the Quillix data sheet may identify a locally stored batch of scanned documents, but it does not identify any particular document through an identification number. Therefore, Claim 71 is patentable over the prior art of record..

Claim 72 recites “wherein the index data input in said step (j) comprises a file path

indicating the subdirectory on the server at which the document data is to be stored.” The ‘batch name’ of the Quillix data sheet is not a file path indicating a subdirectory on the server at which the document data is to be stored. Instead, it is a batch name used locally for a group of scanned documents not specifically identified.” Therefore, Claim 72 is patentable over the prior art of record.

Claim 73 recites “wherein the index data input in said step (j) comprises text explaining the nature of the scanned document.” The ‘batch name’ of the Quillix data sheet is not text explaining the nature of the scanned document. Accordingly, Claim 73 is patentable over the prior art of record.

Claim 74 recites “wherein the index data input in said step (j) identifies a matter to which the scanned document relates.” The ‘batch name’ of the Quillix data sheet does not identify a matter to which the scanned document relates. Therefore, Claim 74 is patentable over the prior art of record.

Claim 75 recites “wherein the index data input in said step (b) identifies a transaction to which the scanned document relates.” The Quillix data sheet fails to indicate that the ‘batch name’ in any way identifies a transaction to which the scanned document relates. Accordingly, Claim 75 is patentable over the prior art of record.

Accordingly, Claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62, and 64-75 are patentable for at least the reasons stated above. Reversal of the rejection of these claims is requested.

## **II. Claims 2, 23, and 63 are Nonobvious under 35 U.S.C. 103 (a) over the “Quillix Data Sheet”**

### **A. The Claimed Invention Patentably Distinguishes over the Quillix Data Sheet**

On page 23 of the Office action, Claims 2, 23, and 63 were rejected under 35 U.S.C. 103(a) based on the Quillix data sheet. The reasons that Claims 2, 23 and 63 are patentable are addressed separately below.

The Examiner has the burden of establishing a prima facie case of obviousness under 35 U.S.C. §103(a). *Ex Parte Martin P. Hageman and Thomas J. Palus*, Appeal No. 2000-1514, Application No. 09/038,450 (citing *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)); *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir.

1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only if the Examiner satisfies this initial burden does the burden of coming forward with evidence shift to the Applicant. *Id.* To satisfy this burden, the Examiner must show (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) a reasonable expectation of success; and (3) the prior art reference, or references when combined, must teach or suggest all the claim limitations. M.P.E.P. §2143, 8<sup>th</sup> Ed., 4th Rev. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. As to motivation, use of hindsight, in effect using the Applicant's disclosure against the Applicant, is not permitted. *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed.Cir. 1988); *In re Rouffet*, 149 F.3d 1350, 1358, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1988); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 U.S.P.Q.2d 1626, 1629-30 (Fed. Cir. 1996); *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989); *In re Fine*, 87 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Furthermore, the teaching, suggestion, or motivation to modify or combine features in an effort to obtain the claimed invention must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Both the references and the claimed invention must be considered as a whole rather than piecemeal. *In re Antonie*, 559 F.2d 618, 620 (CCPA 1977); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

#### **B. Quillix Data Sheet is Not Prior Art**

As explained above, the Quillix Data Sheet is not prior art under 35 U.S.C. 103(a) to the subject application. Accordingly, a prima facie case of obviousness has not been established for this reason.

#### **C. Claims 2, 23 and 63 Patentably Distinguish Over the Prior Art**

Claims 2 and 63 depend from Claim 1, and Claim 23 depends from Claim 9, and thus include all limitations of their respective independent Claims. Thus, Claims 2, 23 and 63 distinguish over the prior art for reasons previously stated with respect to Claims 1 and 9.

In addition, Claim 2 recites "wherein the control element is operable by the user with the input device to alternately generate the start scan signal and the send data signal with respective

successive activations of the control element.” As admitted in the Office action, this feature is not disclosed in the Quillix data sheet. However, the Office action takes Official Notice that “toggle buttons” were well-known in the art. Appellant has repeatedly traversed this assertion because there is no motivation in the prior art that would have led one of ordinary skill in the art to modify toggle buttons to alternately generate start scan and send data signals. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *Ex Parte Patrizia Milazzo et als.*, 2002 WL 1821709 (Bd. Pat. App. & Interf.) (citing *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 U.S.P.Q.2d 1780, 1783-84 n.14 (Fed. Cir. 1992), *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q.2d 1125, 1127 (Fed. Cir. 1984). 12783-4 n. There is simply no motivation in the prior art that would have led one of ordinary skill in the art to modify the Quillix data sheet to include toggle buttons for alternately generating the start scan signal and send data signal with successive activations of the control element. This configuration makes it unnecessary for a coder to move a mouse or other input device when scanning and uploading documents, saving significant time in the coding process. Therefore, Claim 2 is patentable over the Quillix data sheet.

Claim 23 states “wherein the start scan signal and the send data signal are input by the user with the input device via a common control element displayed within the web browser of the user interface that toggles between a first scan mode for the performance of said step (a) and a second send mode for the performance of said step (m).” The prior art contains not the slightest hint of any such common control element toggling between scan and send modes as claimed. Nor is there any suggestion in the prior art to combine such element with the Quillix data sheet in an effort to obtain the claimed invention. Accordingly, Claim 23 is patentable.

Claim 63 recites “index data input in said step (b) comprises a file path indicating the subdirectory on the server at which the scanned document is to be stored.” The Quillix citations do not disclose or even suggest this limitation. Accordingly, Claim 63 is patentable over the prior art.

#### **D. Applicant has “Sworn Behind” the Quillix Data Sheet and Press Release**

As noted in Section 7.I.C above, Applicant has submitted the Declaration of Alexandre Okonechnikov to “swear behind” the March 28, 2000 (though that is not necessary given its “print

date" after the filing date of this application) and the January 18, 2000 press release. Therefore, the Quillix data sheet and press release are not prior art to the subject application, and they cannot be relied upon to reject the Claims under 35 U.S.C. 103(a). It was error for the Examiner not to have considered this Declaration in the examination of the subject application. Withdrawal of the rejection is requested for this reason.

**E. Traversal of Approach to Obviousness Analysis**

The Office action attempts to take Official Notice of the fact that a toggle button was known in the art at the time of the invention. However, under 35 U.S.C. 103(a), the subject matter of the Claims must be considered "as a whole." Thus, the element the Examiner must produce prior art that discloses a toggle button that has the function of scanning a document and transmitting document data by successive activations. That kind of toggle button was not known to anyone else in the art, and the attempt to take Official Notice of the existence of toggle button used for other functions skews the appropriate focus for the obviousness analysis. In other words, the piecemeal approach taken in the Office action by attempting to dissect the claim language rather than consider it as a whole is in error and should be reversed. *See, e.g., In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983).

**F. Failure to Consider Evidence of Secondary Factors Establishing Nonobviousness**

Even assuming the Examiner has established a *prima facie* case of obviousness, the Examiner must further consider any evidence supporting patentability of the claimed invention. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992). The determination of whether an invention is or is not obvious is a legal conclusion considering the based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *In re Dembiczak*, 175 F.2d 994, 998 (Fed. Cir. 1999) (*citing Graham v. John Deere, Inc.*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 15 L.Ed.2d 545, 148 USPQ 459, 465 (1966)). Among the objective evidence that must be considered in an obviousness determination, are included: (1) commercial success of the invention; (2) existence of a long-felt need in the art for the invention; (3) failed attempts of others; and (4) evidence of copying of the invention by others. *Id. See also Pro-Mold and Tool Co., Inc. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 37 USPQ2d 1626 (Fed. Cir. 1996).

In addition to applying the analysis set forth above, the rejection of Claims 2, 23, and 63 under 35 U.S.C. 103(a) failed to take into account the evidence of secondary factors establishing

nonobviousness of the claimed invention. In Exhibits 1-21 of the amendment filed May 7, 2004, the Applicant submitted evidence regarding all of these factors. None of this evidence has been considered and accorded appropriate weight, which is an erroneous approach on which to base an obviousness rejection. Accordingly, Claims 2, 23, and 63 are patentable for this additional reason.

**G. Claim 63 as Amended is Not Directed to Non-Functional Descriptive Material**

Claim 63 recites that the “index data input in said step (b) comprises a file path indicating the subdirectory on the server at which the document data is to be stored.” The Office action alleges that the file path is merely descriptive material. The Federal Circuit cautions against liberal use of the so-called “printed matter” rejection. *In re Gulack*, 703 F.2d at 1385, n.8 (Fed. Cir. 1983). The limitation of Claim 63 is related functionally to the inputting step, and is thus intrinsically bound to the function of inputting the index data which is done differently depending upon what the data to be input is. Further, Claim 1, from which Claim 63 depends, recites that the index data is input in association with the document data into the display generated in step (a). For reasons similar to the holding in *In re Lowry*, 32 F.3d 1579 (Fed.Cir. 1994), which involved structures storing related data, the relationship between the index data and document data is directed to patentable subject matter. Withdrawal of the rejection is requested for this additional reason.

8. ***Claims Appendix.***

An appendix containing a copy of the claims involved in the appeal.

9. ***Evidence Appendix.***

An appendix containing copies of any evidence submitted.

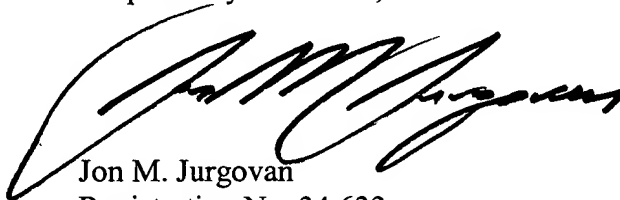
10. ***Related Proceedings Appendix.***

Not applicable.

**CONCLUSION**

Claims 1-16, 18-27, 29-33, 35-53, 55-75 are patentable over the prior art of record for all of the reasons set forth above. Applicant requests reversal of the rejections under 35 U.S.C. 102 and 103(a) of all pending Claims with instructions on remand to the Examiner to promptly issue a Notice of Allowance for all pending claims.

Respectfully submitted,



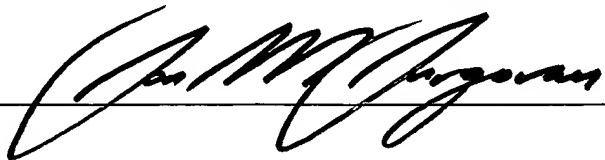
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Jon M. Jurgovan



## Claims Appendix

1. (previously presented) A method comprising the step of:
  - a) generating a display based on a hypertext mark-up language (HTML) document stored in a client device using a web browser of a user interface of the client device, the display including a document display portion, an index field portion, and a control portion all visibly defined in the display in separate portions thereof by the HTML document, the document display portion including a display of document data received from a scanner coupled to the client device, the scanner generating the document data by scanning a document in print form, the document data representing the scanned document, the index field portion permitting index data to be input by a user with an input device of the client device into the user interface in association with the document data, and the control portion including at least one control element operable by the user with the input device for generating a start scan signal to initiate scanning of the document with the scanner to generate the document data and for generating a send data signal to transmit the document data with the index data displayed by the web browser from the client device to the server over a network using a destination address for the server specified in an address field of the web browser.
2. (previously presented) A method as claimed in claim 1, wherein the control element is operable by the user with the input device to alternately generate the start scan signal and the send data signal with respective successive activations of the control element with the input device.
3. (previously presented) A method as claimed in claim 1, wherein the control portion includes at least one control element that can be activated by the user with the input device to adjust the scale of the display of the document data.
4. (previously presented) A method as claimed in claim 3, wherein the control element can be activated by the user with the input device to increase the scale of the display of the document data ("zoom in").



5. (previously presented) A method as claimed in claim 3, wherein the control element can be activated by the user with the input device to decrease the scale of the display of the document data ("zoom out").

6. (previously presented) A method as claimed in claim 3, wherein the control element can be activated by the user with the input device to scale the document data to fit within the document display portion of the display.

7. (previously presented) A method as claimed in claim 3, wherein the control element can be activated by the user with the input device to scale the document data for display in the document display portion to the same scale as the scanned document.

8. (previously presented) A method as claimed in claim 3, wherein the control portion includes a control element activated by the user with the input device to select document data from among a plurality of scanned documents for display on the document display portion of the display.

9. (previously presented): A method comprising the steps of:

a) generating at a client device a start scan signal using a control element defined by a hypertext mark-up language (HTML) document stored in the client device and displayed by a web browser of a user interface of the client device in response to a user's operation of an input device of the client device;

b) at the client device, converting the start scan signal into a form compatible with a scanner;

c) at the client device, transmitting the converted start scan signal from the client device to the scanner;

d) receiving the converted start scan signal at the scanner; and

e) scanning a document with the scanner to generate document data, in response to the converted start scan signal received in said step (d).

10. (previously presented) A method as claimed in claim 9, wherein said step (a) is performed by depressing and releasing a control element of the user interface of the client device using a mouse constituting at least part of the input device.

11. (previously presented) A method as claimed in claim 9, further comprising the steps of:

- f) transmitting the document data from the scanner to the client device;
- g) receiving the document data at the client device;
- h) at the client device, converting the document data into a form that can be displayed within the web browser of the client device; and
- i) generating a display including the scanned document on the web browser of the client device, based on the document data converted in step (h).

12. (previously presented) A method as claimed in claim 11, further comprising the step of:

- j) adjusting the display of the document data via a user's operation of a control element defined by the HTML document displayed by the web browser within the user interface.

13. (previously presented) A method as claimed in claim 12, wherein the adjusting of said step (j) includes increasing the scale of the display of the scanned document ("zooming in") on the user interface.

14. (previously presented) A method as claimed in claim 12, wherein the adjusting of said step (j) includes decreasing the scale of the display of the scanned document ("zooming out") on the user interface.

15. (previously presented) A method as claimed in claim 12, wherein the adjusting of said step (j) includes scaling the display of the scanned document to fit within the document display portion of the display of the user interface of the client device.

16. (previously presented) A method as claimed in claim 12, wherein the adjusting of said step (j) includes generating the display of the scanned document on the user interface of the client device with the same scale as the scanned document.

17. (canceled)

18. (previously presented) A method as claimed in claim 12, further comprising the step of:

k) generating a multiscan mode signal via a user's operation of a control element defined within the web browser at the user interface of the client device, said steps (e)-(g) repeatedly performed to generate document data for a plurality of documents, based on the multimode scan signal.

19. (previously presented) A method as claimed in claim 18, further comprising the steps of:

l) generating a selection signal via a user's operation of a control element defined within the web browser of the client device indicating at least one of the first, last, next and previous scanned documents for display; and

m) displaying the document data for one of the scanned documents within the web browser of the client device, based on the selection signal generated in said step (l).

20. (previously presented) A method as claimed in claim 12, further comprising the steps of:

k) user inputting predetermined index data into an index field defined by the HTML document separately from a document display portion in which the document data from the scanner is displayed by the web browser of the user interface of the client device;

l) generating a send data signal using the control element operated by a user with the input device and defined by the HTML document displayed by the web browser of the user interface of the client device;

m) transmitting the document data and index data from the client device to the server over an internetwork in response to the send data signal generated in said step (l);

n) receiving the document data and index data at the server; and

o) storing the document data in association with the index data in a database of a data storage unit separate from the server.

21. (original) A method as claimed in claim 20, wherein the index data includes predetermined identification data to identify the document.

22. (original) A method as claimed in claim 20, wherein the document data and the index data are transmitted between the server and client device in hypertext transfer protocol (HTTP).

23. (previously presented) A method as claimed in claim 20, wherein the start scan signal and the send data signal are input by the user with the input device via a common control element displayed within the web browser of the user interface that toggles between a first scan mode for the performance of said step (a) and a second send mode for the performance of said step (m).

24. (previously presented) A method as claimed in claim 20, wherein the start scan signal is input by a user with the input device via a first control element displayed within the web browser of the user interface for a first scan mode in the performance of said step (a) and the send data signal is input by a user with the input device via a second control element displayed within the web browser of the user interface in the performance of said step (m).

25. (previously presented) A method as claimed in claim 9, further comprising the step of:

f) transmitting the document data from the client device to a server.

26. (previously presented) A method as claimed in claim 9, further comprising the step of:

f) transmitting the document data from the scanner to a server.

27. (previously presented) A method comprising the steps of:

a) generating a start scan signal using a control element defined by a hypertext mark-up language (HTML) document stored in the client device and displayed by a web browser of a user

interface of a client device, the control element operated by a user with an input device of the client device;

b) at the client device, converting the start scan signal into a form compatible with the scanner;

c) transmitting the converted start scan signal from the client device to a scanner;

d) receiving the converted start scan signal at the scanner;

e) scanning a document in print form with the scanner to generate document data, in response to the converted start scan signal received in said step (d);

f) transmitting the document data from the scanner to the client device;

g) receiving the document data at the client device;

h) at the client device, converting the document data into a form that can be displayed by the web browser of the client device;

i) generating a display including the scanned document in the HTML document displayed within the web browser of the user interface of the client device, based on the document data converted in said step (h);

j) inputting predetermined index data into a field defined separately from a document display portion for the document data in the HTML document displayed by the web browser of the user interface of the client device, the index data associated with the document data displayed by the web browser;

k) generating a send data signal using a control element defined in the HTML document displayed by the web browser of the user interface of the client device;

l) transmitting the document data and index data from the client device to the server over an internetwork in response to the send data signal generated in said step (k) using a destination address of the server specified in an address field of the web browser;

m) receiving the document data and index data at the server via the internetwork; and

n) storing the document data received in step (m) in association with the index data in a database of a data storage unit separate from the server.

28. (canceled)

29. (previously presented) A method as claimed in claim 27, further comprising the step

of:

o) adjusting the display of the scanned document via a user's operation of a control element defined by the HTML document displayed by the web browser within the user interface.

30. (previously presented) A method as claimed in claim 29, wherein the adjusting of said step (o) includes increasing the scale of display of the scanned document ("zooming in") on the user interface.

31. (previously presented) A method as claimed in claim 29, wherein the adjusting of said step (o) includes decreasing the scale of the display of the scanned document ("zooming out") on the user interface.

32. (previously presented) A method as claimed in claim 29, wherein the adjusting of said step (o) includes scaling the display of the scanned document to fit within the document display portion of the display of the user interface of the client device.

33. (previously presented) A method as claimed in claim 29, wherein the adjusting of said step (o) includes generating the display of the scanned document on the user interface of the client device with the same scale as the scanned document.

34. (canceled)

35. (previously presented) A method as claimed in claim 29, further comprising the step of:

p) generating a multiscan mode signal via a user's operation of a control element defined within the web browser of the user interface of the client device, said steps (e) - (g) repeatedly performed to generate document data for a plurality of documents, based on the multimode scan signal.

36. (previously presented) A method as claimed in claim 29, further comprising the steps

of:

p) generating a selection signal via a user's operation of a control element defined within the web browser at the client device indicating at least one of the first, last, next and previous scanned documents for display; and

q) displaying the document data for one of the scanned documents within the web browser of the client device, based on the selection signal generated in said step (p).

37. (original) A method as claimed in claim 29, wherein the index data includes predetermined identification data to identify the document.

38. (previously presented) A method as claimed in claim 29, wherein the document data and the index data are transmitted in said step (l) between the server and client device in hypertext transfer protocol (HTTP) format.

39. (previously presented) A method as claimed in claim 29, wherein the start scan signal and the send data signal are input by the user with the input device via a common control element defined within the web browser of the user interface that toggles between a first scan mode for the performance of said step (a) and a second send mode for the performance of step (l).

40. (previously presented) A method as claimed in claim 29, wherein the start scan signal is input by the user with the input device via a first control element defined within the web browser of the user interface for a first scan mode in the performance of said step (a), and the send data signal is input by the user with the input device via a second control element defined within the web browser of the user interface in the performance of said step (l).

41. (previously presented): A system for use with at least one document, the system comprising:

a client device including  
a processor;

a memory coupled to the processor;  
an input device coupled to the processor; and  
a display unit coupled to the processor;  
a scanner coupled to the processor; and  
at least one server coupled to the processor,  
the processor operating under a predetermined control program stored in the memory to generate a display on the display unit based on a hypertext mark-up language (HTML) document stored in the memory, the display generated by the HTML document including a document display portion, an index field portion, and a control portion separately defined in the display, the document display portion displaying document data received from a scanner, the document data generated by scanning the document with the scanner, the index field portion permitting index data to be input by a user via the input device for association with the document data, and the control portion including at least one control element operable by the user with the input device for use in generating at least a start scan signal to initiate scanning of the document with the scanner and for use in generating a send data signal with the input device to transmit the document data with the index data to the server over a network using a destination address from an address field of the display of the client device.

42. (previously presented) A system as claimed in claim 41, wherein the control element alternates between generating the start scan signal and the send data signal between successive activations of the control element by the user with the input device.

43. (previously presented) A system as claimed in claim 41, wherein the control element can be operated by the user with the input device to adjust the scale of the display of the document data.

44. (previously presented) A system as claimed in claim 41, wherein the control element can be operated by the user with the input device to increase the scale of the display of the document data ("zoom in").

45. (previously presented) A system as claimed in claim 41, wherein the control element



can be operated by the user with the input device to decrease the scale of the display of the document data ("zoom out").

46. (previously presented) A system as claimed in claim 41, wherein the control element can be operated by the user with the input device to scale the document data to fit within the document display portion of the user interface.

47. (previously presented) A system as claimed in claim 41, wherein the control element can be operated by the user with the input device to scale the document data for display in the document display portion to the same scale as the scanned document.

48. (previously presented) A system as claimed in claim 41, wherein the control element can be operated by the user with the input device to select document data from among a plurality of scanned documents for display on the document display portion of the display.

49. (previously presented) A system as claimed in claim 41, wherein the server receives document data and index data from the client device, the system further comprising:

a database storage unit coupled to the server, the database storage unit being separate from the server, for storing the index data in association with the document data from the processor.

50. (previously presented): A system used to scan a document, the system coupled to a network, the system comprising:

a client device;

a scanner coupled to the client device;

a server coupled to the client device via the network; and

a database storage unit coupled to the server,

the client device receiving document data generated by the scanner by scanning a document, the client device having a user interface capable of generating a display by execution of an hypertext mark-up language (HTML) document stored by the client device, the display including a document

display portion, an index field portion, and a control portion separately defined in the display, the document display portion displaying document data received from the scanner, the document data generated by scanning the document in print form with the scanner, the document data representing the scanned document, the index field portion permitting index data to be input by a user via an input device of the client device for association with the document data, and the control portion including at least one control element operated by the user with the input device for use in generating at least a start scan signal with the input device to initiate scanning of the document with the scanner and for use in generating a send data signal with the input device to transmit the document data with the index data to the server over the network using a destination address from an address field of the display, the server storing the document data and index data in the database storage unit.

51. (original) A system as claimed in claim 50, wherein the network includes an internetwork.

52. (original) A system as claimed in claim 50, wherein the client device includes a personal computer.

53. (original) A system as claimed in claim 50, wherein the user interface includes a web browser in which the document data is displayed.

54. (canceled)

55. (previously presented): A system coupled to a network, the system operated by at least one user, the system comprising:

a plurality of subsystems coupled to the network, the subsystems having respective client devices capable of displaying document data included within respective hypertext mark-up language (HTML) documents displayed on corresponding web browsers thereof, at least one of the subsystems including a scanner coupled to a respective client device, the scanner generating the document data by scanning a document in print form based on a first command from a user entered into the web browser of the client device coupled to the scanner, the client device receiving the document data

from the scanner and generating a display of the document data in the web browser thereof, the client device transmitting the document data based on a second command from the user entered into the web browser of the client device;

at least one server coupled to the network, the server receiving the document data from the client device over the network using a destination address specified in an address field of the web browser of the client device; and

a database storage unit coupled to the server, the database storage unit separate from the server, the database storage unit storing the document data so that the subsystems can access the document data.

56. (original) A system as claimed in claim 55, wherein the network includes an internetwork.

57. (previously presented): A method comprising the steps of:

a) generating a display including a display portion with a view of a scanned document within a browser of a client device based on document data derived from a scan of a document in print form;

b) inputting predetermined index data into at least one field of an index field portion of the display within the browser of the client device, the index field portion defined in the display within the browser separately from the display portion;

c) generating a send data signal from within the browser of the client device using a control element of a control portion defined separately from the index field portion and the display portion in the display within the browser;

d) transmitting the document data and index data from the client device to the server over an internetwork with the control element of the control portion using a destination address of a server identified in an address field of the browser in response to the send data signal generated in said step (c);

e) receiving the document data and index data at the server; and

f) storing the document data in association with the index data received from the server in a database of a data storage unit separate from the server.

58. (previously presented) A method as claimed in claim 57 wherein the display of the scanned

document is included in a hypertext mark-up language (HTML) document displayed by the browser of the client device's user interface.

59. (previously presented) A method as claimed in claim 58 wherein the send data signal is generated in step (c) by activating a control element defined in the HTML document.

60. (previously presented) A method as claimed in claim 1 further comprising:  
b) inputting index data identifying the document data into the index field portion.

61. (previously presented) A method as claimed in claim 60 wherein the index data input in said step (b) comprises a document name identifying the scanned document.

62. (previously presented) A method as claimed in claim 60 wherein the index data input in said step (b) comprises an identification number identifying the scanned document.

63. (currently amended) A method as claimed in claim 60 wherein the index data input in said step (b) comprises a file path indicating the subdirectory on the server at which the [[scanned]] document data is to be stored.

64. (previously presented) A method as claimed in claim 60 wherein the index data input in said step (b) comprises text explaining the nature of the scanned document.

65. (previously presented) A method as claimed in claim 60 wherein the index data input in said step (b) identifies a matter to which the scanned document relates.

66. (previously presented) A method as claimed in claim 60 wherein the index data input in said step (b) identifies a transaction to which the scanned document relates.

67. (previously presented) A method as claimed in claim 60 further comprising the step of:  
c) activating the control element by the user with the user interface to scan the document with a

scanner to generate the document data.

68. (previously presented) A method as claimed in claim 67 further comprising the step of:

d) activating the control element by the user to upload the document data representing the scanned document to a server over a network.

69. (previously presented) A method as claimed in claim 27 wherein the index data input in said step (j) identifies the scanned document.

70. (previously presented) A method as claimed in claim 69 wherein the index data input in said step (j) comprises a document name identifying the scanned document.

71. (previously presented) A method as claimed in claim 69 wherein the index data input in said step (j) comprises an identification number identifying the scanned document.

72. (previously presented) A method as claimed in claim 27 wherein the index data input in said step (j) comprises a file path indicating the subdirectory on the server at which the scanned document is to be stored.

73. (previously presented) A method as claimed in claim 27 wherein the index data input in said step (j) comprises text explaining the nature of the scanned document.

74. (previously presented) A method as claimed in claim 27 wherein the index data input in said step (j) identifies a matter to which the scanned document relates.

75. (previously presented) A method as claimed in claim 27 wherein the index data input in said step (j) identifies a transaction to which the scanned document relates.

76. (canceled)

### **Evidence Appendix**

1. Declaration of Alexandre Okonechnikov – filed July 21, 2005 with Amendment of same date
2. Declaration of Mayanne Pace – Exhibit 1, Amendment filed May 7, 2004
3. Declaration of Teresa Benavidez – Exhibit 2, Amendment filed May 7, 2004
4. Declaration of Kevin Bennett – Exhibit 3, Amendment filed May 7, 2004
5. Intertech Information Management, Inc. Announces Application Service Provider Model – Exhibit 4, Amendment filed May 7, 2004
6. Intellisys Uses Intertech Solution to Help Ascensus and CNA Life Cut Costs and Decrease Processing Time with New Imaging System – Exhibit 5, Amendment filed May 7, 2004
7. Intertech Signs First Healthcare Customer to its ASP Service - Exhibit 6, Amendment filed May 7, 2004
8. Announcing New Team in Health Information Management - Exhibit 7, Amendment filed May 7, 2004
9. Joint Staff and Arlington and Inova Fairfax Hospitals Select Intertech Web-Based Document Management Solution - Exhibit 8, Amendment filed May 7, 2004
10. Distributed Data and Document Capture: Cost and Architecture Issues – Exhibit 9, White Paper - Kofax Image Products, May 2002
11. Ascent Richochet product Overview - Exhibit 10, Amendment filed May 7, 2004
12. Financial Brokerage Speeds New Account Applications with Distributed Document Capture - Exhibit 11, Amendment filed May 7, 2004
13. Product Fact Sheet, Imaging for Everyone – Exhibit 12,
14. More About ImageNow - Exhibit 13, Amendment filed May 7, 2004
15. ImageWare Document Manager 2001 Workgroup Edition - Exhibit 14, Amendment filed May 7, 2004
16. Scanportal Web Capture [http://www.scanportal.com/pages/scanportal\\_web\\_capture.htm](http://www.scanportal.com/pages/scanportal_web_capture.htm) - Exhibit 15, Amendment filed May 7, 2004

17. DATACAP, Task Master Web  
<http://web.archive.org/web/20021211043606/www.datacap.com/components/TMweb.asp>  
- Exhibit 16, Amendment filed May 7, 2004
18. AscentCapture Internet Server - Exhibit 17, Amendment filed May 7, 2004
19. KMWORLD, The Solution for All Your Capture Needs - Exhibit 18, Amendment filed May 7, 2004
20. Financial Brokerage Speeds New Account Applications with Distributed Document Capture - Exhibit 19, Amendment filed May 7, 2004
21. Breakthrough Software Enables Web-Based Distributed Document Capture - Exhibit 20, Amendment filed May 7, 2004
22. Prevalent Software, Inc. Introduces Quillix - Exhibit 21, Amendment filed May 7, 2004
23. PERICOM, document capture:  
<http://web.archive.org/web/20030724183746/http://www.pericomimaging.com/capture.html>  
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24. 2001 RELEASE, 3M Health Information Systems Division Launches Outsourced Coding Service - Exhibit 23, Amendment filed May 7, 2004